

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
GROUP ART UNIT 3643**

EXAMINER: Son T. Nguyen
APPELLANT: Ali Nilforushan
SERIAL NO.: 10/559860
FILED: December 6, 2005
FOR: Animal Cover Having a Temperature Altering Device

MS Appeal Brief - Patents
Commissioner of Patents and Trademarks
Washington, D.C. 20231
Attention: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF UNDER 37 CFR § 41.37

This brief is filed with the appellant's Notice of Appeal filed in this manner on December 11, 2009. The fees required under §1.17 and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains the following items under the headings in the following order:

- I. Real Party In Interest
- II. Related Appeals And Interferences
- III. Status Of Claims
- IV. Status Of Amendments
- V. Summary Of Claimed Subject Matter
- VI. Grounds of Rejection To Be Reviewed On Appeal
- VII. Argument
- VIII. Claims Appendix
- IX. Evidence Appendix
- X. Related Proceedings Appendix

I. Real Party In Interest

The real party in interest is the assignee, Recover Blankets LLC.

II. Related Appeals And Interferences

There are no other appeals or interferences in this matter known to appellant.

III. Status Of Claims

1. Claims pending: 61-68 and 70-75;
2. Claims rejected: 61-68 and 70-75;
3. Claims cancelled: 1-60 and 69;
4. Claims on appeal: 61-68 and 70-75.

IV. Status Of Amendments

No amendments were filed after final rejection. The claims were rejected in the final Office Action mailed September 14, 2009 based on amendments and arguments entered in response to non-final Office Action mailed January 5, 2009. Section VIII recites the claims as entered/pending and under final rejection.

V. Summary Of Claimed Subject Matter

The claimed subject matter as recited in independent **claim 61** is drawn to a temperature altering system (*e.g.*, abstract; figs. 1a-4b) that includes a blanket sized and dimensioned to drape over a horse (*e.g.*, page 1, par. 6; figs. 1a-4b). First and second pockets can be disposed on an underside of the blanket (*e.g.*, page 3, par. 35; figs. 4a-4b), with each pocket having a cavity that includes a removable temperature altering device (*e.g.*, page 5, par. 49). Each of the pockets can be freely positioned about the blanket using hook and loop fasteners (*e.g.*, page 2, par. 28; page 3, pars. 33 and 37). The size of the first pocket can be different from the size of the second pocket (*e.g.*, page 3, par. 33; fig. 1a). A flap can be coupled to the blanket, and have another pocket positioned to deliver a temperature altering regimen to a stifle joint of the horse (*e.g.*, page 4, pars. 40-45; figs. 4a-4b and 6).

VI. Grounds of Rejection To Be Reviewed On Appeal

1. Rejection of claims 61, 63, 67, 70, and 72-75 under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) (See final office action, page 2).
2. Rejection of claims 62 and 66 under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Newman (US Pat. No. 5271211) (See final office action, page 6).
3. Rejection of claim 64 under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Fazio (US Pat. No. 6443101) (See final office action, page 6).
4. Rejection of claim 65 under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Beeghly et al. (US Pat. No. 5537954) (See final office action, page 7).
5. Rejection of claim 68 under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Schulte (DE Pat. Appl. No. 4140507) (See final office action, page 8).
6. Rejection of claim 71 under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Longtin (US Pat. Appl. No. 2003/0061790) (See final office action, page 8).

VII. Argument

(1) Rejection Of Claims 61, 63, 67, 70, And 72-75 Under 35 U.S.C. 103(a) As Being Obvious Over Uhr In View Of Taudauchi Et AL., Wilson, And Osborn

Claims 61, 63, 67, 70, and 72-75 were rejected under 35 U.S.C. 103(a) as being obvious over Uhr, in view of Taudauchi et al., Wilson, and Osborn. As discussed below, the proposed combination of four references is improper because the Office fails to identify a sufficient teaching, suggestion, or motivation to combine the various references.

It is well recognized that the factual inquiry whether to combine references must be based on objective evidence of record. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a *showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’*”). The courts have held that “...teachings of references can be combined only if there is *some suggestion or incentive to do so.*” (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). Indeed, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed (see, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). Thus, the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Even post *KSR*, the office is reminded that “...[I]n formulating a rejection under 35 U.S.C. 103(a) based upon a combination of prior art elements, *it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.*...” (USPTO Memorandum of May 3, 2007 from Deputy Commissioner Foccarino to TC directors).

In the instant case, the Office first asserts that it would have been obvious to combine the teachings of Taudauchi with that of Uhr to “allow the user to move the [temperature] altering device in various different locations.” (Office Action, page 3). And further, the Office asserts

that it would have been obvious to combine the teachings of Uhr and Tadauchi with that of Wilson to "accommodate different sizes of the temperature altering devices." (Office Action, page 3). However, such statements simply recite the *purpose* of each element, and *fail to identify a reason* why one of ordinary skill in the art at the time of filing would have been motivated to modify the Uhr blanket to add freely positionable pockets and differently sized pockets. If mere purpose (i.e. functionality) of elements in a claimed combination could substitute for reason to combine those elements, then the requirement for suggestion, teaching, or motivation would be eliminated. The Office does not have the power to circumvent holdings of the Supreme Court.

The real question in this case is whether one of ordinary skill in the art, knowing of a horse blanket having fixed pockets like Uhr's, would be motivated to modify Uhr's solution to heat or cool an area of a horse by using other solutions in the art that address the same problem: (1) freely positionable pockets of a horse harness taught by Tadauchi; and (2) differently sized fixed pockets taught by Wilson. A person of ordinary skill in the art would contemplate heating or cooling a specific target area of horse by either (1) selecting one of the many fixed pockets for the desired target area (e.g., Wilson), or (2) placing some of the freely positionable pockets having the same size at the target area (e.g., Tadauchi), but would have no motivation to utilize both solutions.

Because each of Tadauchi and Wilson convey to one of ordinary skill in the art that they have completely solved the same problem, one of ordinary skill in the art would not have been motivated to combine the two solutions. *See Ex parte Debora Rinkevich*, Appeal No. 2007-1317 (BPAI 2007). Wilson's device apparently functions in a completely adequate manner without freely positionable pockets, since one could select one of the many fixed pockets for the desired target area. Similarly, Tadauchi's device also appears to function in a completely adequate manner without using pockets with varying sizes, since a user can place multiple heating or cooling pockets at the desired target area. As such, Tadauchi and Wilson each fail to teach, suggest or motivate a person of ordinary skill in the art to combine their two solutions to arrive at the subject matter as claimed. The addition of Osborn to the combination is merely to show a leg flap, and adds nothing to the analysis. The bottom line is that the alleged motivation to combine references that was suggested by the Office is insufficient to support a finding of obviousness.

As a backup argument, the Office also asserts that the claimed invention "does not include any new concept." (Office Action, page 11). Such statement, however, is insufficient to support a finding of obviousness. Contrary to the Office's assertion, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 167 L. Ed. 2d 705 (2007).

The motivation to modify Uhr using Taudauchi, Wilson and Osborn as offered by the Office is simply improper, and the Applicant respectfully requests the rejection of claim 61 to be withdrawn. In addition, the rejections of claims 63, 67, 73, and 74 should also be withdrawn by virtue of their dependency on independent claim 61.

(2) Rejection of claims 62 and 66 under 35 U.S.C. 103(a) as being obvious over Uhr in view of Taudauchi et al., Wilson, Osborn, and Newman

Claims 62 and 66 were rejected under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Newman (US Pat. No. 5271211) (See final office action, page 6).

As claims 62 and 66 are dependent on claim 61, the same arguments and considerations as provided above under (1) apply and are not reiterated here. For at least the reasons discussed above, the rejection of claims 62 and 66 should be withdrawn.

(3) Rejection of claim 64 under 35 U.S.C. 103(a) as being obvious over Uhr in view of Taudauchi et al., Wilson, Osborn, and Fazio

Claim 64 was rejected under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Fazio (US Pat. No. 6443101) (See final office action, page 6).

As claim 64 is dependent on claim 61, the same arguments and considerations as provided above under (1) apply and are not reiterated here. For at least the reasons discussed above, the rejection of claim 64 should be withdrawn.

(4) Rejection of claim 65 under 35 U.S.C. 103(a) as being obvious over Uhr in view of Taudauchi et al., Wilson, Osborn, and Beeghly et al.

Claim 65 was rejected under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Beeghly et al. (US Pat. No. 5537954) (See final office action, page 7).

As claim 65 is dependent on claim 61, the same arguments and considerations as provided above under (1) apply and are not reiterated here. For at least the reasons discussed above, the rejection of claim 65 should be withdrawn.

(5) Rejection of claim 68 under 35 U.S.C. 103(a) as being obvious over Uhr in view of Taudauchi et al., Wilson, Osborn, and Schulte

Claim 68 was rejected under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl. No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Schulte (DE Pat. Appl. No. 4140507) (See final office action, page 8).

As claim 68 is dependent on claim 61, the same arguments and considerations as provided above under (1) apply and are not reiterated here. For at least the reasons discussed above, the rejection of claim 68 should be withdrawn.

(6) Rejection of claim 71 under 35 U.S.C. 103(a) as being obvious over Uhr in view of Taudauchi et al., Wilson, Osborn, and Longtin

Claim 71 was rejected under 35 U.S.C. 103(a) as being obvious over Uhr (DE Pat. Appl. No. 20021260) in view of Taudauchi et al. (JP Abstract No. 410113088), Wilson (GB Pat. Appl.

No. 2374535) and Osborn (US Pat. No. 233275) and further in view of Longtin (US Pat. Appl. No. 2003/0061790) (See final office action, page 8)

As claim 71 is dependent on claim 61, the same arguments and considerations as provided above under (1) apply and are not reiterated here. For at least the reasons discussed above, the rejection of claim 71 should be withdrawn.

CONCLUSION

In its rejections, the Office fails to provide support for its rejections of the claims as obvious, and therefore the rejection should be withdrawn.

Respectfully submitted,
FISH & ASSOCIATES, PC

Date: February 9, 2010

By _____
Robert D. Fish, Esq.
Reg. No. 33880
Tel.: (949) 943-8300

VIII. CLAIMS APPENDIX

1-60. (Canceled)

61. A temperature altering system, comprising:

a blanket sized and dimensioned to drape over a horse;

first and second pockets disposed on an underside of the blanket, each of which has a cavity that includes a removable temperature altering device, and each of which is freely positionable about the blanket using hook and loop fasteners,

wherein the first pocket has a first size and the second pocket has a second size that is different from the first size; and

a flap coupled to the blanket, wherein the flap includes another pocket positioned to deliver a temperature altering regimen to a stifle joint of the horse.

62. The system of claim 61, wherein the underside of the blanket includes a wicking material.

63. The system of claim 61, wherein the first pocket has a flap disposed to assist in keeping a corresponding one of the temperature altering devices within a cavity of the first pocket.

64. The system of claim 61, wherein the first pocket has a zipper disposed to assist in keeping a corresponding one of the temperature altering devices within a cavity of the first pocket.

65. The system of claim 61, wherein the first pocket has a button disposed to assist in keeping a corresponding one of the temperature altering devices within a cavity of the first pocket.

66. The system of claim 61, wherein the first pocket has a temperature reflective material on a side adjacent the blanket.

67. The system of claim 61, wherein the pockets mate with a top side of the blanket.

68. The system of claim 61, wherein the temperature altering device is a series of electrically controlled heating elements.

69. (Canceled)

70. The system of claim 61, wherein the blanket further comprises a leg flap coupled to a rear portion of the blanket, and including an additional pocket.

71. The system of claim 61, wherein the blanket further comprises a detachable neck protrusion, wherein the protrusion includes an additional pocket.

72. The system of claim 61, wherein the blanket further comprises a front end and a rear end, wherein the front end includes a cut away portion that rests just above a withers region of the horse, and wherein the rear end of the blanket covers a horse's hindquarter region. .

73. The system of claim 61, wherein the first size and dimension of the first pocket is configured to contact the horse's spinal muscles.

74. The system of claim 61, wherein the second size and dimension of the second pocket is configured to contact at least one of the horse's shoulder and hip muscles.

75. The system of claim 61, wherein the blanket further comprises a row of fixed pockets positioned to deliver the temperature altering regimen to a horse's spinal muscles.

IX. EVIDENCE APPENDIX

No evidence was submitted pursuant to §§ 1.130, 1.131, or 1.132.

X. RELATED PROCEEDINGS APPENDIX

No related proceedings are known to the appellant.